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Date December 1, 2004

To Examiner Thong Q. NGUYEN

Of PTO Group Art Unit 2872

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From Jason C. Beckstead, Reg. No. 48,232

Subject Reply Brief under 37 C.F.R. § 41.41

Our Ref A7694 Appln No 09/883,357

Conf No 9655 Inventors Lothar K. FABER

Pages 9 (including cover sheet)

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In re application of

Docket No: A7694

Lothar K. FABER

Appln. No.: 09/883,357

Group Art Unit: 2872

Confirmation No.: 9655

Examiner: Thong Q. NGUYEN

Filed: June 18, 2001

For: FLUORESCENCE MICROSCOPE

PAPER ENTITLED: 1) Reply Brief

8 pages

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PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: A7694

Lothar K. FABER

Appln. No.: 09/883,357

Group Art Unit: 2872

Confirmation No.: 9655

Examiner: Thong Q. NGUYEN

Filed: June 19, 2001

For: FLUORESCENCE MICROSCOPE

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated October 1, 2004. Entry of this Reply Brief is respectfully requested.

Attorney Docket No. A7694
PATENT APPLICATION

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appl. No.: 09/883,357

STATUS OF CLAIMS

Claims 1 – 20 are pending in the application. Of the previous claims, claims 2 – 6 and 10 – 19 have been withdrawn from consideration. Thus, claims 1, 7 – 9 and 20 are finally rejected and are the subject of the Appeal associated with this Reply Brief.

Attorney Docket No. A7694
PATENT APPLICATION

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/883,357

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The rejection to be reviewed comprises the rejection of claims 1, 7 - 9 and 20 under 35 U.S.C.

§ 103 over Fehr (U.S.P. No. 4,697,893) in view of Koyama (U.S.P. No. 6,226,118).

Attorney Docket No. A7694
PATENT APPLICATION

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/883,357

ARGUMENT

Appellant responds as follows to the Examiner's Answer dated October 1, 2004.

The Examiner continues to hold to an incomplete statement of the law of obviousness,¹ resulting in Appellant's secondary considerations² being ignored. The Examiner would require every patent applicant alleging copying by a competitor to show that the alleged copier tried for a substantial period of time to produce a product similar to Applicant's, but failed and then copied Applicant's claimed invention. The Examiner cites *Dow Chem. Co. v. American Cyanamid Co.*, 837 F.2d 469, 2 USPQ2d 1350 (Fed. Cir. 1987) and M.P.E.P. § 716.06 as allegedly controlling.

Contrary to the Examiner's assertions, Appellant submits that secondary considerations, including allegations of copying, require an investigation by the finder of fact into the specific facts of record. Invariably, facts will differ on a case-to-case basis. In the instant case, the Examiner is misguided in his sole reliance on *Dow Chem. Co.* Indeed, Supreme Court precedence mandates four factual inquiries³ to resolve the issue of obviousness (commonly

¹ The Examiner bases his rejection on an incomplete statement of law that would require Appellant to show that the alleged copier of Appellant's claimed invention tried for a substantial length of time to design a product similar to Appellant's, but failed and then copied the claimed invention instead. See the Office Action dated January 12, 2004, at page 6; see also the Examiner's Answer dated October 1, 2004, at pages 5 and 6.

² Appellant's secondary considerations include allegations of copying by a competitor. Appellant submits that copying by a competitor has been established on a preponderance of the record, as captured at pages 5 - 10 of the Appeal Brief filed July 20, 2004.

³ The four factual inquiries are: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the claimed invention and the prior art; and 4) secondary considerations of nonobviousness, which in case law is often said to include commercial success,
...(footnote continued)

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known as the Graham factors). One of the Graham factors is a factual inquiry into secondary considerations, including “considerations of nonobviousness, which in case law is often said to include commercial success, long-felt but unresolved need, failure of others, *copying*, and unexpected results.” *Id.* (Emphasis added.)

While the Examiner cites *Dow Chem. Co.* as controlling, the Examiner is misguided because the *Dow Chem. Co.* case merely iterates facts found to be persuasive to the Federal Circuit.⁴ *Id.* Notably, *Dow Chem. Co.* is only applicable to the present patent application as one example of when the Federal Circuit has found evidence of copying to be persuasive of nonobviousness. That is, *Dow Chem. Co.* stands for affirmative facts found to be persuasive to the Federal Circuit. *Id.* To follow the Examiner’s logic, a negative inference needs to be drawn from the *Dow Chem. Co.* case – *a negative inference which is not within the four corners of the Federal Circuit’s published decision in Dow Chem. Co., or any other decision published by the Federal Circuit or any case decided by the Board of Patent Appeals and Interferences.*

In view of the previous, Appellant maintains that *Dow Chem. Co.* does not control the facts of the instant case.⁵ Furthermore, copying of Appellant’s claimed invention has been

long-felt but unresolved need, failure of others, *copying*, and unexpected results. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662-63 57 USPQ3d 1161, 1165 (Fed. Cir. 2000) (emphasis added) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966)).

⁴ The noted facts being that evidence of copying was persuasive of nonobviousness when an alleged infringer tried for a substantial period of time to design a product similar to the claimed invention, but failed and then copied the claimed invention instead. *Id.*

⁵ The facts of the instant case establishing copying by a competitor are captured at pages 5 – 10 of Appellant’s Appeal Brief filed July 20, 2004.

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established by a preponderance of the record.⁶ And yet because the Examiner continues to hold to the above-described incomplete statement of the law of obviousness, Appellant's secondary considerations have not been properly considered.

The Examiner's failure to analyze Appellant's secondary considerations is captured at pages 5 – 10 of the Appeal Brief filed July 20, 2004. In this vein, Appellant submits:

In an appeal of a rejection of a patent application, secondary considerations, such as commercial success, typically do not play a large part in the analysis of obviousness because the inventor usually waits until his patent issues before he swings production into full gear. Thus, a detailed analysis of secondary considerations is more common in cases like *John Deere*, which involved infringement. If, however, a patent application properly presents evidence relating to these secondary considerations, *the board must always consider such evidence in connection with the determination of obviousness.*

In re Sernaker, 702 F.2d at 996, 217 USPQ at 7 (Fed. Cir. 1983) (emphasis added).

In considering the evidence of secondary considerations of record, Appellant highlights Part XIII(1)(D) of the Appeal Brief filed July 20, 2004, which notes that the Examiner's instant rejection barely amounts to a preponderance.⁷ When analyzed in view of Appellant's secondary evidence, however (as noted above in Parts VIII(1)(A-C) of the Appeal Brief of July 20th: a competitor copying the claimed device), it is clear that any preponderance is lost, and therefore the

⁶ See FN 5.

⁷ An obviousness rejection under 35 U.S.C. § 103 requires a minimum threshold of a preponderance of the evidence. See M.P.E.P. § 2142; see also *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

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Examiner's obviousness rejection based on the cited references is improper and should be overturned. Accordingly, Appellant respectfully requests such relief from the Board.

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CONCLUSION

For the above reasons as well as the reasons set forth in the Appeal Brief dated July 20, 2004, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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Date: December 1, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this REPLY BRIEF UNDER 37 C.F.R. § 41.41 is being facsimile transmitted to the U.S. Patent and Trademark Office this 1st day of December, 2004.



Mariann Tam